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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,361

12/08/2003

David Claxton

UTSC:776US

2826

32425 7590 07/03/2006

FULBRIGHT & JAWORSKI L.L.P.  
600 CONGRESS AVE.  
SUITE 2400  
AUSTIN, TX 78701

EXAMINER

ARNOLD, ERNST V

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/730,361	<b>Applicant(s)</b> CLAXTON ET AL.	
	<b>Examiner</b> Ernst V. Arnold	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11, 12 and 38-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 and 38-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The Examiner acknowledges receipt of remarks filed on 02/02/2006 to the first office action. However, upon further consideration, a new ground(s) of rejection is made. Therefore, this action is non-final.

Claims 10 and 13-37 have been cancelled. Claims 38-58 have been added.

Claims 1-9, 11, 12 and 38-58 are pending.

#### **Withdrawn rejections:**

Applicant has amended the specification and the Examiner withdraws the objection.

Cancellation of claims 10 and 13 render the claim rejections moot and the rejections are withdrawn.

Claims 1, 6-8 and 12 were rejected under 35 USC 102(b) as being anticipated by Grollier et al. (US 4,481,185). Applicant's arguments, with respect to Grollier et al., have been fully considered and are persuasive. The rejection of claims 1, 6-8 and 12 has been withdrawn.

Claims 2, 3, 9 and 11 were rejected under 35 USC 103(a) as being unpatentable over Grollier et al. in view of Alving et al. (US 5,820,880). Applicant's arguments, with respect to Grollier et al. in view of Alving et al., have been fully considered and are persuasive. The rejection of claims 2, 3, 9 and 11 has been withdrawn.

Claims 2-5 were rejected under 35 USC 103(a) as being unpatentable over Grollier et al. in view of Boch et al. (US Patent App. 2002/0156062). Applicant's

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arguments, with respect to Grollier et al. in view of Boch et al., have been fully considered and are persuasive. The rejection of claims 2-5 has been withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 38 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 38 and 49 are drawn to a composition comprising emodin, or a derivative thereof. Applicant has not defined how far one of ordinary skill in the art could derivatize emodin and still use the invention. What is essential for function? Applicant has provided a small number of examples but not an entire genus.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9, 11, 12 and 38-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 38 and 49 recite

emodin. The Merck Index provides two definitions of emodin thus making it unclear which emodin applicant is claiming (see attached Merck Index). The Examiner suggests inserting the full chemical name of the emodin Applicant is claiming (see page 2 of the specification). Claims 2-9, 11, 12, 39-48 and 50-58 are rejected as being indefinite because they are dependent on an indefinite base claim.

***Claim Rejections - 35 USC § 112***

Claims 1-9, 11, 12 and 38-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 38 and 49 are drawn to a composition comprising emodin or a derivative thereof. It is unclear to the Examiner the metes and bounds of "a derivative thereof". Is it a functional derivative or a structural derivative? It is unclear to the Examiner how far can one of ordinary skill in the art can derivatize emodin and still retain functionality. Claims 2-9, 11, 12, 39-48 and 50-58 are rejected as being indefinite because they are dependent on an indefinite base claim.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

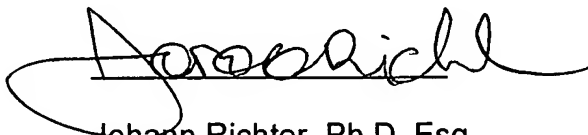
No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernst V. Arnold whose telephone number is 571-272-8509. The examiner can normally be reached on M-F (6:15 am-3:45 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ernst Arnold  
Patent Examiner  
Technology Center 1600  
Art Unit 1616  
May 02, 2006

A handwritten signature in black ink, appearing to read 'Johann Richter', with a large, stylized loop at the beginning.

Johann Richter, Ph.D. Esq.  
Supervisory Patent Examiner  
Technology Center 1600